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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,718	12/28/2001	Grigor Markarian	CIT10243	4085
27510	7590	10/31/2007		
KILPATRICK STOCKTON LLP			EXAMINER	
607 14TH STREET, N.W.			BORISSOV, IGOR N	
WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	DELIVERY MODE
			10/31/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/028,718	<b>Applicant(s)</b> MARKARIAN ET AL.	
	<b>Examiner</b> Igor N. Borissov	<b>Art Unit</b> 3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 08/17/2007 is acknowledged and entered. Claims 14-17 have been amended. Claims 12 and 14-18 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton (US 2005/0027610) in view of Bednarek (US 6,965,868).**

Wharton teaches a method and system for dynamically converting data between a mobile station in a wireless communication network and an origin server in a wide area network, comprising:

Claims 12 and 14-18,

sending from a customer device a Wireless Markup Language (WML) encoded URL request for a resource; receiving said request at a gateway server and re-formatting said request into HTML format; communicating said re-formatted request to a particular resource information on the World Wide Web, and receiving the requested resource information at said gateway; parsing said received resource information and re-formatting the processed information into WML encoded message to transmit it back to the customer device; sending a purchase request to a merchant website; sending a

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purchase request response, including a payment authorization request, from the merchant website to a payment authorization system; and transmitting said purchase request response to the customer device (Figs. 1 and 4); [0009]; [0010]; [0046]; [0051]; [0053].

While Wharton teaches that said arrangement is implemented in a wireless network, Wharton does not specifically teach the customer device is a *mobile* device.

Bednarek teaches a method and system for promoting e-commerce, wherein a merchant sells goods or services using a website, and a customer communicates with the merchant via a customer *mobile* device, and wherein data transmitted between the merchant and the customer *mobile* device is converted by the server to a format that can be displayed on the customer *mobile* device (C. 68, L. 65 – C. 69, L. 15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wharton to include that communication with the customer is conducted by means of customer mobile device, as disclosed in Bednarek, because it would advantageously allow to provide the customer with information correlated to the customer current cellular position, such as gas stations, hotels, restaurants and grocery stores, as specifically stated in Bednarek, thereby providing convenience to the customer. Furthermore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

### ***Response to Arguments***

Applicant's arguments filed 08/17/2007 have been fully considered but they are not persuasive.

Applicant argues, that so as Wharton does not teach a customer *mobile* device, Wharton does not teach the functionalities associated with the customer mobile device as recited in independent claims 12 and 18.

In response to this argument, it is noted that Wharton discloses a customer device, and functionalities associated with that customer devices. The secondary reference (Bednarek) was applied to show that said customer device can be implemented as mobile device. (See a discussion above). Moreover, said "mobile" feature for which Bednarek was applied, is suggested in Wharton, which specifically teaches that said arrangement is implemented in a wireless network.

Also, Applicant argues, that Bednarek fails to teach receiving a purchase request and transmitting a purchase request response to a mobile device.

In response to this argument, it is noted that Wharton was applied to this feature (See the discussion above). To this end Examiner points out that applicant's arguments are directed against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As per applicant's argument that Bednarek teaches away from receiving a purchase request and transmitting a purchase request response to a mobile device, it is noted that Bednarek was applied to show that said customer device can be implemented as mobile device. Said feature was already suggested in Wharton, which specifically teaches that said arrangement is implemented in a wireless network.

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**Conclusion**


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB  
10/23/2007



IGOR N. BORISSOV  
PRIMARY EXAMINER